

REMARKS

Upon entry of the above amendments, this application will contain claims 1-34 and 37-74 pending and under consideration. The application was originally filed with claims 1-34. In a Preliminary Amendment, claims 35 and 36 were canceled and new claims 40-74 were added. In the present submission, the claims have been further amended. As discussed more fully below, it is believed that the claims are patentable. Reconsideration leading to allowance of all pending claims is requested.

I. Provisional Obviousness Double Patenting Rejection

Claims 1-34 and 37-74 were provisionally rejected on the ground of judicially created non-statutory double patenting over the claims of claims 1-20 and 23-25 of the copending application, serial no. 10/510,393 (publication no. US2005/0240001, hereinafter "Evers '001"). Specific reference was made to the species in claim 25 in Evers '001.

Upon indication of allowable subject matter, the undersigned will submit an acceptable terminal disclaimer in this case of the co-pending case, which ever case is allowed last.

Claims 1-34 and 37-74 were rejected on the ground of judicially created non-statutory double patenting over claims 1-44 of US 7,125,840 (hereinafter "Dodge"). Specific reference was made the species in claim 44. The applicants respectfully traverse this rejection.

Claims 1 and 5 have been amended to recite that the substituted C₁-C₆ alkyl variable for R₁, in the first of the six independent provisos, is substituted with the groups listed in the present application at ¶0120, i.e., halo, hydroxyl, -OC₁-C₆ alkyl, cyano, SO₂(C₁-C₆ alkyl), OCF₃, CF₃, CONH₂, CON(CH₃)₂, or NO₂. (All citations to the present application refer to the published US patent application no. US 2006/0167268.) Therefore, the first proviso does not include compounds in which the alkyl group can be substituted with an alkyl substituted with one or more methyl groups as urged in the latest Office Action (Office Action, page 7.)

The species recited in claim 44 of Dodge is 2-(R)-2-(2-Amino-2-methylpropionylamino)-3-phenylmethoxy propionic acid N-(5-(4-chlorophenyl)-3,3-dimethyl-1,1-dioxo-2,3-dihydroisothiazol-4-ylmethyl)-N-ethylamide. This species is not within the first proviso of claim 1 because the 2-amino-2-methylpropionylamino at the R₁ locus is not a (substituted C₁-C₆alkyl)NHR₁₀ or (unsubstituted or substituted C₃-C₈cycloalkyl)NHR₁₀ group.

This species is not within the second proviso of claim 1 because the ethyl group at the R₅ locus is not hydroxy, C₁-C₆alkoxy, or substituted C₁-C₆alkyl.

This species is not within the third proviso of claim 1 because the methyl groups at the R6 and R7 loci are not unsubstituted or substituted C₁-C₆alkyl or unsubstituted or substituted C₂-C₆alkenyl with the proviso that at least one group is substituted.

This species is evidently not within the forth or fifth proviso of claim 1 due to the definitions for R6 and R7.

This species is not within the sixth proviso of claim 1 because the hydrogen atom at the R8 locus is not substituted C₁-C₆alkyl, substituted aryl, unsubstituted or substituted (C₁-C₆alkyl)C₃-C₈cycloalkyl or substituted C₁-C₆alkylaryl.

Thus, the provisos serve to distinguish this species from those presently claimed. Further, there is no motivation for one skilled in the art to prepare the claimed compounds. It is respectfully maintained that a bare allegation that one skilled in the art would be motivated to prepare the claimed compounds is not sufficient to establish a prima facie case of obviousness. It still remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. There has been no articulated reason why one would be motivated to select the particular substituents on the variables R1, R5, R6, R7, and R8 as presently claimed. The Examiner's reliance on In re Lemin is misplaced. In Lemin, the application at issue was a selection case, where the prior art reference broadly disclosed the claimed compounds. In re Lemin, 141 USPQ 814, 815 (CCPA 1964). However, in the present application, the prior art reference, Dodge, does not disclose a genus that encompasses any of the claimed compounds.

Furthermore, the present case is not one where the prior art reference discloses homologs, structural or optical isomers, or acids and esters of the claimed compounds, but rather where the claimed compounds include substituents not contemplated by the prior art. The rejection provides no reasoned statement that supports the rejection that one skilled in the art would be motivated to prepare the specific compounds. In light of the above comments, withdrawal of the non-statutory double patenting over Dodge of claim 1 and claims 2-38 and 45-74, which depend directly or indirectly from claim 1, and of claims 39-44, which include one or more of the same elements for R1, R5, R6, R7, and R8 as described above, is requested.

II. Rejections Under 35 USC § 112

Claims 2, 3 and 5 are rejected under U.S.C. 112, second paragraph, as being indefinite for failing to include an "or" before the last individual definition of R6 and R7. Claims 2, 3, and 5 have been accordingly. Withdrawal of this rejection is requested.

III. Rejections Under 35 USC § 102

Claims 1, 5, 22-32, 27, 38 and 63-68 were rejected under 35 U.S.C. 102(e) alleged for being anticipated by Dodge. As noted above in claim 1 the first proviso for the substituted alkyl group variable for R1 has been amended to recite the specific substituents on the substituted alkyl group. Claim 5 has been similarly amended. The remaining rejected claims depend either directly or indirectly from claim 1 or 5. In light of this amendment, withdrawal of the rejection is requested.

IV. Claim Amendments

In addition to the claim amendments mentioned above, claims 14, 19, 59, 65 and 71 have been amended to correct minor typographical errors. Claims 14 and 19 have been amended in the third line from the end by replacing C3-C8 with C₃-C₈. Claims 59, 65 and 71 have been amended in the second line from the end by adding a semi colon. It is believed that these amendments do not add new matter.

V. Conclusion

Applicants respectfully request timely examination of this application leading to allowance of all elected claims. The Examiner is invited to contact the undersigned attorney by telephone if there are any questions about this Response or other issues that may be resolved in that fashion.

Respectfully submitted,

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